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In re Application of	:	OFFICE OF PETITIONS
Philip Scanlan	:	
Application No. 10/657,555	:	DECISION ON PETITIONS
Filed: September 4, 2003	:	UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. WORLDLING003-02	:	AND 37 CFR 1.55(c)

This is a decision on the petition under 37 CFR 1.78(a)(2), filed February 7, 2006, which is being treated as both a petition under 37 CFR 1.78(a)(3) and 37 CFR 1.55(c)¹ to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed international Application No.PCT/AU02/00249, filed March 5, 2002, and under 35 U.S.C. § 119(a)-(d) for the benefit of priority to prior-filed foreign Application No. PR3607, filed March 6, 2001, as set forth in the concurrently filed amendment.

As to the benefit claim under 37 CFR 1.78(a)(3):

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1).

¹ It is appropriate here to treat the petition also as one under 37 CFR 1.55(c). In this regard, although a reference to the foreign application was made in the declaration at the time of filing, the Office did not recognize the priority claim since the foreign application was filed more than one year from the filing date of this application.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed application. An example of an appropriate reference to a PCT application in the first sentence of the specification is: "This application is a continuation of International Application PCT/EP2004/00000, with an international filing date of January 5, 2004, now abandoned." See MPEP Section 1895.01. A benefit claim that merely states: "This application claims the priority of commonly owned PCT Application Serial No. PCT/AU02/00249" does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each prior-filed application (if it is patented or abandoned) should also be indicated, following the filing date of the parent application. See MPEP Section 201.11, Reference to Prior Nonprovisional Applications. The present amendment fails to comply with 37 CFR 1.72(a)(2)(i) and is therefore unacceptable.

As to the benefit claim under 37 CFR 1.55(c):

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) the nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date, **and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6));**
- (3) the surcharge as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Director may require additional information where there is a question whether the delay was unintentional); and
- (5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The petition under 37 CFR 1.55(c) is **DISMISSED**.

The petition fails to comply with item (5) above. Without a grantable petition to accept the delayed claim for benefit of the PCT application, it would be inappropriate to accept the late claim for priority to the foreign application since the filing date of the foreign application is more

than one year from the filing date of the present application. Once the petition to accept the late claim for benefit of priority to the PCT application under 37 CFR 1.78(a)(3) has been granted, then the claim for priority to the foreign application would be acceptable.

Before the petition for a late claim for benefit of priority to the PCT and foreign applications can be granted, a renewed petition under 37 CFR §§ 1.78(a)(3) and 37 CFR 1.55(c) and an Application Data Sheet or a proper amendment (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)), which states the relationship of the prior-filed PCT application to this application, are required. Petitioner is advised that the reference to the foreign application is more appropriately made in the oath or declaration or an Application Data Sheet, not as part of an amendment to the first line of the specification following the title.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
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By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
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Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.



Frances Hicks
Petitions Examiner
Office of Petitions